

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte REX R. CARLSON, RICH SCHNEIDER, SCOTT BOYD and MILES
PATCEG

Appeal No. 2001-0258
Application No. 08/821,978

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and
BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-46, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a gaming machine which accepts wagers from a player and, more particularly, to a video gaming machine in which a second chance means displayed on the video monitor concomitantly along with a first chance means has a

potential effect on an outcome and award for the player (specification, p. 2). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Weingardt	5,042,818	Aug. 27, 1991
Chadwick et al. (Chadwick)	5,344,145	Sep. 6, 1994
Netley et al. (Netley)	5,868,618	Feb. 9, 1999
		(filed Sep. 30, 1996) ¹

(1) Claims 10, 17 and 18 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

(2) Claims 10, 17-27 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weingardt in view of Netley.

(3) Claims 11-16, 28-33 and 35-46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Weingardt in view of Netley, as applied to claims 10, 17, 27 and 34, and further in view of Chadwick.

¹ Appellants argue that Netley is not available as a prior art reference against appellants' claims because "[i]ts publication date is inappropriate as a reference" (brief, p. 18). Be that as it may, Netley's filing date of September 30, 1996, which precedes the March 20, 1997 filing date of the instant application, qualifies it as prior art against appellants' claims under 35 U.S.C. § 102(e).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 7 and 11) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 10) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The basis of the examiner's indefiniteness rejection of claims 10, 17 and 18 is that "there are simply [too] many **or clauses** in the claims so as to make the claim extremely broad such that almost any piece of prior art with two gambling means could read on the claims" (final rejection, p. 2). In the answer (p. 3), the examiner explains that the limitations within the "or" clauses oppose each other and thus are made indefinite.

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Recognizing, as the examiner does (answer, p. 5) that the inclusion of alternative terminology in a claim does not necessarily render the claim indefinite (See In re Gaubert, 524 F.2d 1222, 1227, 187 USPQ 664, 667-68 (CCPA 1975), we also share the examiner's view that, in this instance, the use of alternative claim terminology raises an ambiguity as to the scope of the claims. For reasons explained in more detail in our new ground of rejection, infra, in light of appellants' underlying disclosure, including all of appellants' claims, and in light of appellants' arguments (brief, pp. 16-21), the claims are ambiguous as to whether they require a step of or means for selecting between two alternatives offered by the gaming machine or whether the claims are generic in that they cover either of two species².

² The first alternative or species is a second chance means which is linked to the first chance means such that the strategy in playing the first chance means is dependent on the second chance means and the second species is a second chance means which is dissociated from the first chance means such that the strategy in playing the first chance means is independent of the second chance means.

Moreover, with regard to claim 10, it is not clear how the two "or" clauses interact with one another. In particular, it is unclear whether exposing the other chance means in a sequence wherein the other chance means supercedes the altering and makes the player's altering dependent on the other chance means or exposing the other chance means prior to the altering to make the player's altering independent of the other chance means is included within the scope of the claim. Stated differently, it is not certain whether the terms "dependent" and "independent" in the first "or" clause of claim 10 are exclusively associated with the terms "precedes" and "supercedes," respectively.

For the foregoing reasons, the examiner's rejection of claims 10, 17 and 18 under 35 U.S.C. § 112, second paragraph, is sustained.³ However, because our explanation as to why the alternative terminology in claims 10 and 17 renders the claims indefinite differs somewhat from that articulated by the examiner and in light of our additional observations with respect to the claims on appeal in our new ground of rejection, infra, we denominate our affirmance of the indefiniteness rejection as a

³ It is not apparent to us why the examiner did not include claims 11-16, which depend from claim 16, or claims 19-26, which depend from claim 17, in this indefiniteness rejection. In any event, we have included these claims in our new ground of rejection, infra.

new ground of rejection pursuant to 37 CFR § 1.196(b) to give appellants an opportunity to respond thereto.

The obviousness rejections

We shall not sustain the examiner's 35 U.S.C. § 103(a) rejections of claims 10-46. For the reasons expressed below in our new ground of rejection pursuant to 37 CFR § 1.196(b), these claims are indefinite. Therefore, the prior art rejections must fall because they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 10-46⁴ are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

The recitation in claim 10 of a step of "exposing other chance means⁵ to the player in a sequence which makes the player's altering dependent on or independent of the other chance means based on whether the exposing step precedes or supersedes the altering" appears to require a step of selecting between two possible sequences, one in which the step of exposing the other chance means precedes the player's alteration of one of the chance means and another in which the exposing step supercedes the player's alteration of one of the chance means. Similarly, claim 17 recites "strategy sequencing means coupled to said second chance means having enabling means to link or dissociate said first chance means from or to said second chance means

⁴ While our inclusion of claims 10, 17 and 18 in this new ground of rejection might seem redundant, in light of our decision to sustain the examiner's rejection of these claims, as discussed above, some of our reasons for concluding that claims 10, 17 and 18 are indefinite are so inextricably related to our reasons for concluding that the remaining claims on appeal are indefinite that it makes sense to discuss all of these claims together.

⁵ Consistent with appellants' underlying disclosure, which discusses only two chance means, it appears that "other chance means" in claim 10, line 5, and claim 34, line 5, as reproduced in the appendix to appellants' brief, should be "the other [another] of said chance means," in light of the earlier recited step of "displaying to a player more than one chance means" in each of claims 10 and 34.

whereby strategy in playing said first and second chance means are either related or independent." This recitation appears to require structure in the gaming machine for selecting between linked and dissociated first and second chance means. In similar fashion, claim 27 recites "said second chance means having a changeable nature which either displays a characteristic related to or unrelated to said first chance means, whereby if related, influences player strategy regarding said first chance means and, if unrelated, does not alter player strategy." This language implies that the gaming machine is capable of selectively displaying the second chance means so as to be either related or unrelated to the first chance means.

No claim may be read apart from and independent of the supporting disclosure on which it is based. See In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971). We are thus required to read the claims in light of the supporting disclosure. Appellants' specification discloses, in Figures 1-4, several arrangements or variations for playing the game. In each of these variations, the first chance means (primary game) is a poker hand. In the first variation (Figure 1), the gaming machine executes the second chance means (secondary game) after the player has selected the cards to hold and discard (the step

of altering the first chance means), thereby having no effect on the player's strategy with respect to the first chance means. In the second variation (Figure 2), the second chance means is executed prior to the players's selection of the cards to hold and discard, such that the player's strategy may be affected by the outcome of the second chance means. In the third variation (Figure 3), the second chance means is executed prior to the player's selection of hold and discard cards and alters the pay table, thereby influencing the player's strategy with regard to the first chance means. In the fourth variation of the game (Figure 4), the second chance means is executed after the player's selection of hold and discard cards and has no impact on the player's strategy with regard to the first chance means. As disclosed in appellants' specification, each of these variations appears to be a separate embodiment. The specification contains no disclosure of combining these variations in a single gaming machine such that, in playing the game, a selection is made among the four variations. This inconsistency between the claim language and the underlying disclosure presents an ambiguity, as discussed above, as to whether each of the above-mentioned independent claims is directed to a genus claim which covers two species or whether a step of or means for selecting between two

available alternatives provided in the gaming machine is required. Claim 34 is ambiguous as to whether the step of exposing implicitly requires selection between two available alternatives (related or unrelated) or merely recites a genus including two species (related and unrelated). Reading claim 34 in light of the circumstances discussed above with regard to the other independent claims and in light of appellants' arguments on pages 16-21 of the brief⁶, we are unable to resolve this ambiguity with any certainty.

For the foregoing reasons, we conclude that independent claims 10, 17, 27 and 34, as well as claims 11-16, 18-26, 28-33 and 35-46 which depend therefrom, are indefinite.

CONCLUSION

To summarize, the examiner's rejection of claims 10, 17 and 18 under the second paragraph of 35 U.S.C. § 112, second paragraph, is sustained and denominated a new ground of rejection pursuant to 37 CFR § 1.196(b). Additionally, a new rejection of

⁶ In this regard, we note that, in the event that appellants' claims are amended to remove the above-noted ambiguity so as to be of a scope consistent with the arguments on pages 16-21 of appellants' brief, such claims would not appear to be supported by appellants' original disclosure. Accordingly, under such circumstances, the examiner may wish to consider the appropriateness of a written description requirement under 35 U.S.C. § 112, first paragraph.

claims 11-16 and 19-46 under 35 U.S.C. § 112, second paragraph, is entered pursuant to 37 CFR § 1.196(b). The obviousness rejections of claims 10-46 are not sustained.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
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